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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,951	12/17/2001	Mark J. Stefik	111325-88	5128
22204	7590	07/27/2004	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/015,951	Applicant(s) STEFIK ET AL.	
	Examiner Calvin L Hewitt II	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-34 have been examined.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 6, 9, 21, and 24 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hartrick et al., U.S. Patent No. 5,532,920.

As per claims 1-3, 6, 9, 21, and 24, Hartick et al. teach a digital work distribution system comprising:

- digital content representing a portion of a digital work rendered on a rendering device (figure 1)
- usage rights associated with said digital content that indicate one or more ways said work can be used or distributed (figures 3A-7)

- usage rights that further specify status information indicating the status of the digital work and a fee (revenue) type and parameter (e.g. best price fee) (figures 10 and 11)
- storing content and rights on the same device (figure 1; column 4, lines 40-53)
- usage rights that include state information indicating the extent of the manner of use exercised by an authorized user (column 14, lines 15-50; column 15, lines 1-42)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4, 5, 7, 8, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartrick et al., U.S. Patent No. 5,532,920 in view of Sprague et al., U.S. Patent No. 5,247,575.

As per claims 4, 5, 7, 8, and 26, Hartick et al. teach a digital content distribution system where users are charged fees for accessing content (figures 10 and 11). However, Hartick et al. do not specifically recite fees based on time.

Sprague et al. teach a digital content distribution system (abstract; column 24, lines 9-16) where users are charged based on the type or class of content, time or subscription (column 4, lines 8-56; column 13, lines 24-59). Sprague et al. also teach maintaining a database that stores user fee, account and other statistical information (e.g. usage) (column/line 19/63-20/18; column 23, lines 47-66), as well as fee tables, or schedules and authorized users (column 22, lines 59-66; column 23, lines 46-65). Regarding schedules, fee or tables are old and well known. Similarly, "mark-up" prices are old and well known to those of ordinary skill in retail. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Hartrick et al. and Sprague et al. in order to allow users the opportunity to select an access method (e.g. rent, purchase, subscription) that best meets their needs.

6. Claims 10 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartrick et al., U.S. Patent No. 5,532,920.

As per claim 10, Hartick et al. teach that usage rights may be integrated within the text or in a separate file (column 4, lines 45-50; column/line 4/66-5/5). Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to store (e.g. floppy disk, CD-ROM) the rights on a separate disk if additional space was needed.

As per claim 25, Hartrick et al. teach storing book data such as author, title, copyright date and edition (figure 5). Therefore, it would have been obvious to store other bibliographic data such as publisher and publication date.

7. Claims 11-19, 23, and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartrick et al., U.S. Patent No. 5,532,920 in view of Comerford et al. U.S. Patent No. 5,109,413.

As per claims 11-19, 23, and 27-33, Hartrick et al. teach a method and system of content distribution comprising:

- digital content representing a portion of a digital work rendered on a rendering device (figure 1)
- usage rights associated with said digital content that indicate one or more ways said work can be used or distributed (figures 3A-7)
- usage rights that further specify status information indicating the status of the digital work and a fee type and parameter (e.g. best price fee (figures 10 and 11)
- storing content and rights on the same device (figure 1; column 4, lines 40-53)

Regarding storing rights and content on different devices, Hartick et al. teach that usage rights may be integrated within the text or in a separate file (column 4, lines 45-50; column/line 4/66-5/5). Therefore, it would have been obvious to one

of ordinary skill at the time the invention was made to store (e.g. floppy disk, CD-ROM) the rights on a separate disk if additional space was needed. Hartrick et al. also teach storing book data such as author, title, copyright date and edition (figure 5). Therefore, it would have been obvious to stored other bibliographic data such as publisher and publication date. However, Hartrick et al. do not specifically recite distribution rights. Comerford et al. teach a software distribution system where a user can obtain rights to execute (e.g. no. of executions, period of time) and transfer software (abstract; figure 19; column/line 18/38-20/42; column 29, lines 17-47). Regarding schedules, fee or tables are old and well known. Similarly, "mark-up" prices are old and well known to those of ordinary skill in retail. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Hartick et al. and Comerford et al. in order to provide publishers with a mechanism for allowing users to share content within the copy protection parameters set by the publisher ('413, column 2, lines 5-22).

8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartrick et al., U.S. Patent No. 5,532,920 in view of Wolfe, U.S. Patent No. 4,796,220.

As per claim 22, Hartrick et al. teach a digital distribution system of right protected content where users are charged fees for accessing content (figures 3A-7, 10 and 11). However, Hartrick et al. do not specifically recite indicating the

number of copies in use. Wolfe teaches a method for controlling the copying of software comprising indicating the number of copies (abstract; column 2, lines 32-52). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Hartrick et al. and Wolfe et al. in order to allow publishers to track the number of copies in use and charge accordingly ('220, column 1, lines 40-46; column 4, lines 49-68).

9. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartrick et al., U.S. Patent No. 5,532,920 and Comerford et al. U.S. Patent No. 5,109,413 as applied to claim 27 above, and in further view of Sprague, U.S. Patent No. 5,247,575.

As per claim 34, Hartick et al. teach a digital content distribution system where users are charged fees for accessing content (figures 10 and 11). Comerford et al. teach a software distribution system where a user can obtain rights to execute (e.g. no. of executions, period of time) and transfer software (abstract; figure 19; column/line 18/38-20/42; column 29, lines 17-47). However, neither Hartrick et al. nor Comerford et al. specifically recite tracking the history of at least one of use and distribution of the digital work. Sprague et al. teach a digital distribution system that maintains at a user site a database that stores user fee, account and other statistical information (e.g. usage) (column/line 19/63-20/18; column 23, lines 47-66), as well as fee tables, or schedules and

authorized users (column 22, lines 59-66; column 23, lines 46-65). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Hartrick et al., Comerford et al. and Sprague et al. in order to allow users the opportunity to select an access method (e.g. rent, purchase, subscription) that best meets their needs.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Narasimhalu et al. teach incorporating usage rights and history with content
- Grundy teaches content distribution
- McCarty teaches providing distribution rights to a user

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Art Unit: 3621

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and
after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application
should be directed to the Group receptionist whose telephone number is (703)
308-1113.

Calvin Loyd Hewitt II

July 21, 2004



JAMES P. TRAMMELL
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